

REMARKS

Claims 1-6 are pending in the present application. Claims 1-6 stand rejected. The pending rejections are presented in a second non-final Office Action.

I. 35 U.S.C. § 102(e) Rejection

Claims 1 and 3-5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Tucek, U.S. Patent 2004/0138708. The effective date of Tucek as a 102(e) reference is January 15, 2003. Filed herewith is a Declaration of the inventor pursuant to 37 CFR § 1.131 showing a date of the invention prior to January 15, 2003. In particular, the Declaration under 37 CFR § 1.131 shows an actual reduction to practice in August 2002, prior to the effective date of the Tucek reference. The actual reduction to practice occurred in the United States of America.

Applicant's Declaration under 37 CFR § 1.131 effectively overcomes the Tucek reference.

II. 35 U.S.C. § 103 Rejections

Claims 2 and 6 stand rejected as being unpatentable over Tucek pursuant to 35 U.S.C. § 103(a). As described above, Applicant has submitted a declaration effectively swearing behind the Tucek reference. Applicant's 37 CFR § 1.131 Declaration is also effective to overcome the pending obviousness rejection.

Claims 1-4 and 6 stand further rejected under 35 U.S.C. § 103(a) as being unpatentable in view of Ostrow, U.S. Patent No. 5,741,317 and further in view of Bassler, et al., U.S. Patent 4,410,495. The Examiner contends that Ostrow teaches all elements of Applicant's Claims 1-4 and 6 except for Applicant's electrode comprising an outer cylindrical conductor and an inner cylindrical conductor. The Examiner relies upon Bassler to teach Applicant's claimed electrode configuration.

Applicant respectfully submits that the Examiner's combination of Ostrow with Bassler for the purposes of supporting an obviousness rejection, is improper for several reasons. Applicant disputes that Bassler is a reference from the same field of endeavor. Bassler teaches an ozonizer which may be used in, "industrial applications ... for wastewater purification, air quality improvement, drinking water treatment, food storage, as well as in medicine and chemistry." Bassler, column 1, lines 12-17. Furthermore, ozonizers are high energy devices which operate through corona discharge. Applicant's electrodes are relatively low energy devices which deliver a safe, low level, non-ozonizing trickle charge (Application, ¶ 20). Thus, an ozonizer as described in Bassler is not analogous to the therapeutic electrode based treatment

apparatus of the present application and Ostrow. The coincidental fact that both an ozonizer and therapeutic devices such as described in the present application or Ostrow both utilize electrodes does not by itself support any conclusion that Bassler is from the same field of endeavor. Since Bassler is not analogous prior art, the Examiner's reliance upon Bassler is inappropriate (MPEP 2141.01(a)).

The Examiner contends at page 5 of the present Office Action that the motivation to combine Bassler with Ostrow may be found in the advantage of more economical ozone production taught by Bassler, column 2, lines 14-17. Applicant appreciates that the dual sleeve electrode configuration of Bassler can lead to more economical ozone production. However, this motivation is merely motivation to produce an electrode having an inner and outer sleeve. Thus, the Bassler motivation is expressly limited to only a portion of Applicant's Claim 1. There is no motivation whatsoever to be found in Bassler for combining an electrode having an inner and outer cylinder with the other elements recited in Claim 1, which are allegedly suggested by Ostrow.

The Examiner alternatively contends that it would be a matter of obvious design choice to a person of ordinary skill in the art to modify the Ostrow system with an electrode comprising an outer cylinder and inner cylinder. The Examiner further states that Applicant has not disclosed that the specific electrode design claimed by Applicant provides an advantage, is used for a particular purpose or solves a stated problem. The Examiner contends that one of ordinary skill in the art would have expected Applicant's invention to perform equally well with the plate electrodes as taught by Ostrow.

Applicant respectfully submits that various functional and therapeutic advantages of Applicant's novel and non-obvious electrode configuration are described and illustrated in the application. These advantages include but are not necessarily limited to advantages associated with a first embodiment of Applicant's electrode illustrated in Figs. 7 and 9 wherein the electrode is sized to fit between a user's feet. In this and other embodiments, the electrode has a height dimension which allows the electrostatic field lines described at page 8, line 3, (paragraph 047 of the published application) to encompass the tissues of a normal foot in a relatively uniform manner. Plate electrodes such as described in the Ostrow patent would necessarily cause a user's foot to be subjected to a gradient of charges ranging from greater to lesser the farther a select portion of the foot is positioned away from a given flat electrode.

Applicant also describes a second embodiment of this invention at page 7, line 11 and Fig. 6 where the outer conductive electrode is large enough that the user's feet are placed between it and the inner electrode. This embodiment is within the scope of the subject matter of claims 1, 4 and 5. The electrode configuration of Fig. 6 is particularly advantageous for assuring that all portions of a user's feet are positioned within the most therapeutic zone.

Accordingly, Applicant respectfully submits that the claimed electrode configuration is functional, provides well specified therapeutic benefits, and is not an obvious design variation of Ostrow.

The Examiner admits that neither Ostrow nor Bassler disclose the remaining limitations of Claim 1; that the power source include a circuit breaker and that the current between the conductors range from 0.1 to 4 amps. The Examiner contends that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide these expressly claimed elements. Similarly, the Examiner admits that the elements disclosed in Claims 2, 3 and 6 are not disclosed by Ostrow or Bassler. In each case, the Examiner argues that the claimed limitations would have been obvious to one of ordinary skill in the art at the time of the invention.

Evidence of the motivation, suggestion or teaching to combine the references may be found "in explicit or implicit teachings within the references themselves, from the ordinary knowledge of those skilled in the art, or from the nature of the problem to be solved." *WMS Gaming, Inc. v. International Game Tech.*, 184 F.3d 1339, 1355; 51 U.S.P.Q.2D (BNA) 1385 (Fed. Cir. 1999). Irrespective of the source of the teaching, suggestion, or motivation, the Examiner must make an objective showing that would lead to the combination of references. See *In re Fine*, 837 F.2d 1071, 1074; 5 U.S.P.Q.2D (BNA) 1596 (Fed. Cir. 1988). See also *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317; 73 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2004). The Examiner must "identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination" at the time the invention was made. *In re Rouffet*, 149 F.3d 1350, 1359; 47 U.S.P.Q.2D (BNA) 1453 (Fed. Cir. 1998). Mere identification of each individual element of the claimed invention in the prior art "without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." *In re Dembiczak*,

175 F.3d 994, 999; 50 U.S.P.Q.2D (BNA) 1614 (Fed. Cir. 1999). See also *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317; 73 U.S.P.Q.2d (BNA) 1225 (Fed. Cir. 2004).

The foregoing fundamental principle of obviousness analysis was recently reiterated by the Court of Appeals for the Federal Circuit. In the matter of *In Re Kahn* 441 F.3d 977; 78 U.S.P.Q.2D (BNA) 1329 (Fed. Cir. 2006), the Federal Circuit describes the burden upon the Board of Patent Appeals to objectively explain the suggestion, motivation, or teaching relied upon in an obviousness analysis. The Federal Circuit's reasoning is equally applicable to rejections made during the examination process. In particular the Federal Circuit in *Khan* states:

"to establish a prima facie case of obviousness based on a combination of elements disclosed in the prior art, the Board must articulate the basis on which it concludes that it would have been obvious to make the claimed invention. In practice, this requires that the Board "explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious." (internal citation omitted) This entails consideration of both the "scope and content of the prior art" and "level of ordinary skill in the pertinent art" aspects of the Graham test.

When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, we infer that the Board used hindsight to conclude that the invention was obvious. (internal citation omitted) The "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront.

A suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. . . . The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art (internal citations omitted). However, rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"

In re Khan at 987.

Thus, the Federal Circuit has unambiguously confirmed that the showing of the motivation, suggestion, or teaching to combine must be "clear and particular," requiring the presentation of factual findings. *In re Dembiczak*, 175 F.3d at 999, 50 U.S.P.Q.2D (BNA) 1614. Such findings must be made even when changes from the prior art are minor or simple. See *In re*

Chu, 66 F.3d 292, 298; 36 U.S.P.Q.2D (BNA) 1089 (Fed. Cir. 1995). Broad conclusory statements about the teachings of the references, on their own, are never sufficient to satisfy this requirement. See *In re Dembicza*k, 175 F.3d at 999, 50 U.S.P.Q.2D (BNA) 1614.

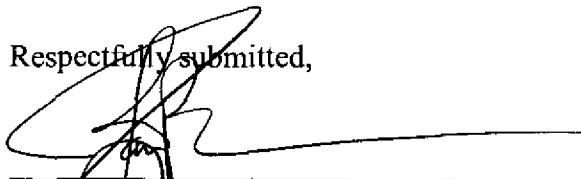
In the present matter, the Examiner has presented no clear and particular presentation of factual findings in support of his obviousness conclusion. For example, the Examiner presents no factual findings supporting his conclusion that plate electrodes as taught by Ostrow would perform in the same manner as the inner and outer cylindrical electrodes of Applicant's invention. Similarly, the Examiner makes no clear and particular statement of fact in support of his conclusion that, "it is known that current below 0.1 amps is of insufficient magnitude for a human to detect while currents above 4 amps may become dangerous to the user." (Office Action page 7) The Examiner presents no clear and particular findings in support of his conclusion that the bolt with insulating sleeve of Applicant's Claim 3 is in fact an alternate equivalent to the insulating tube retaining element of Bassler. (Office Action page 8)

Claim 5 stands further rejected in view of the combination of Ostrow, Bassler and Kurokawa. Kurokawa is relied upon to teach the use of an operation timer. The Examiner admits that the function of the Kurokawa timer is unclear. It is inappropriate for the Examiner to speculate concerning the teaching of prior art references. Accordingly, this combination of references does not teach all of the elements of claim 5. Furthermore, there is no motivation contained in either reference or obvious to one of ordinary skill in the art at the time of the invention to modify the references to reach the claimed subject matter.

For the reasons set forth above, Applicant respectfully submits the claims as filed are allowable over the art of record and reconsideration and issuance of a notice of allowance are respectfully requested. If it would be helpful to obtain favorable consideration of this case, the Examiner is encouraged to call and discuss this case with the undersigned.

This constitutes a request for any needed extension of time and an authorization to charge all fees therefor to deposit account No. 19-5117, if not otherwise specifically requested. The undersigned hereby authorizes the charge of any fees created by the filing of this document or any deficiency of fees submitted herewith to deposit account No. 19-5117.

Respectfully submitted,



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